

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on September 23, 2004, and the references cited therewith.

Claims 11 and 41 are amended to obtain grammatical correctness, and not for reasons related to patentability. Claims 11-54 are pending in this application.

§103 Rejection of the Claims

Claims 11-54 were rejected under 35 USC § 103(a) as being unpatentable over Lhoest (U.S. 5,946,217) in view of Nakagawa (U.S. 6,711,874) and Neary (U.S. 6,751,524). Applicant reserves the right to swear behind selected references at a later date. The rejection is respectfully traversed on the basis that the combination of the reference, even if proper, do not teach or suggest the currently claimed invention.

The present claims all refer to the independence of checking a checkweigher. In other words, the integrity of the checkweigher is checked independent of the checkweigher itself. It begs the question, who is checking the checkers? Claim 11 recites independent integrity checking logic and sensors that are independent from the checkweigher system. Claim 22 independently senses a pack on a conveyor line of the checkweigher and provides messages independent of the checkweigher. Claim 27 uses logic independent from the checkweigher. Claim 35 refers to a kit to check the integrity of a checkweigher that includes independent sensors, as well as the messages independent of the checkweigher. The remaining independent claims refer to a similar independence in checking the checkweigher integrity.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent

some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). At the same time, however, although it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979)).

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness because even if the references are combined, they fail to teach or suggest all of the elements of applicant's claimed invention. The Office Action of September 23, 2004 does not indicate how Lhoest discloses elements of the claims. For instance, claim 11 refers to a conveyor belt. Lhoest is indicated as having a roller or chain conveyors, not a conveyor belt. Claim 11 refers to checkweigher logic. The Office Action only refers to weighing, and references Col. 12, lines 10-28 which alludes to "a device for weighing by strain gauge". No reference is made to checkweigher logic as claimed. Further, claim 11 refers to a pack reject device. No reference to such an element is found in the Office Action. Since each and every

element has not been pointed out in the references, or their combination, a *prima facie* case of obviousness has not been established, and the rejection should be withdrawn.

The Office Action further indicates that "Lhoest does not expressly disclose, but Nakagawa discloses use of a weight checker (30) (construed as a checkweigher) with integrity check circuitry (see figures 9a and 10, for example) as part of a pharmaceutical packaging apparatus with conveyor (310). The Office Action does not point out how the integrity check circuitry is independent from the checkweigher as claimed. In fact, figures 9a and 10 of Nakagawa show that any potential form of integrity checking is a part of the checkweigher, and not independent therefrom. Applicants also do not see any semblance of integrity checking in figures 9a and 10. It appears that there is logic for determining whether a product is underweight or overweight, which is a part of any checkweigher. Since integrity checking logic appears to be lacking from the references, the rejection should be withdrawn.

The Office Action also indicates that "Lhoest does not expressly disclose, but Neary discloses a system of gap control between successive items for a conveyor system having photoeyes (48(a-1), and which detects position of items relative to the conveyor system. (See abstract and figures 1-10.) It should be pointed out that claims referring to spacing of packs is done in the context of checking the integrity of a checkweigher. The sensing of packs on the checkweigher is independent in claim 22, and a message is provided independent of the checkweigher. There is no connection identified between the gap control and a checkweigher in Neary. The rejection should be withdrawn as each and every element arranged as in the claims is not shown or suggested by the combination of the references.

The references are not properly combinable to arrive at the present invention. Even though all the references may be related industrial systems and article handling, there is no suggestion to apply independent integrity checking to a checkweigher. The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01. The Office Action points out what each reference does, and then makes the statement that:

"At the time of the invention, it would have been obvious to use the Lhoest's system to feed pharmaceutical to Nakagawa's packaging system with check weighing system. The suggestion/motivation would have been to package

pharmaceutical materials that are handled by Lhoest's system. Also Note that Lhoest's system detects weight of various containers and stations. See Lhoest, col. 12, lines 19-23. At the time of the invention, it would have been obvious to use the gap control system of Neary's conveyor system in Lhoest's system. The suggestion/motivation would have been to insure the packages are properly singulated with an adequate gap between them. See Neary, col. 3, lines 36-47."

No identification of where the prior art suggests the desirability of the combination is provided. The Office Action appears to state that the suggestion to combine Lhoest and Nakagawa was to package pharmaceutical materials that are handled by Lhoest. This does not appear to be taken from the prior art. Reference to Lhoest detecting weight of various containers and stations also does not suggest the combination. The Office Action indicates that Neary and Lhoest should be combined "to insure the packages are properly singulated", and appears to base the suggestion on the desired result, versus finding the suggestion within the prior art. No motivation having anything to do with independently checking a checkweigher has been established, and the combination still does not teach or suggest all the elements of the claims as arranged in the claims. The rejection should be withdrawn.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

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CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney ((612) 373-6972) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 17 day of December, 2004.

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